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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,480	03/23/2004	Claudio Filippone		1700

7590 07/09/2007
CLAUDIO FILIPPONE
8708 48TH PLACE
COLLEGE PARK, MD 20740

EXAMINER

NGUYEN, HOANG M

ART UNIT	PAPER NUMBER
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3748

MAIL DATE	DELIVERY MODE
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07/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/806,480

Applicant(s)

FILIPPONE, CLAUDIO

Examiner

Hoang M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's request for pre-appeal conference has been fully considered. After the conference, a new ground of rejection has been made.

Applicant argued the waste heat turbine in Striebich is not inherently connected with an electric generator. Even though the Examiner disagrees because 1) the system in Striebich is used in an automotive vehicle, not a lawn mower, the crankshaft must be connected with an electric generator, and 2) Striebich states that his turbine generates power, however, in order to settle any dispute, the Examiner would like to present a 103 rejection instead of a 102 rejection. US 5327987, Abdelmalek, discloses a waste heat expander drives an electric generator 109. It would have been obvious to use the turbine in Striebich to drive an electric generator as taught by Abdelmalek for the purpose of generating electricity.

Applicant argued the free wheel clutch in Striebich does not need a control unit. Again, in order to settle any dispute, the Examiner is taking a position that it would have been obvious to replace said free wheel clutch by the clutch with a control unit as taught by Abdelmalek for the purpose of more effectively controlling the engagement of the clutch.

Applicant argued the obviousness double patenting is not valid. The Examiner disagrees because Applicant fails to provide any elements that are not recited in the claims of the prior patents. Because the claims in the prior patents anticipate the claims

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of this application, the obviousness double patenting is proper and should be maintained.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-50, 51-58, are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 4590766 (Striebich) in view of U.S. 5327987 (Abdelmalek).

Striebich discloses an auxiliary power unit for an ICE 1, said auxiliary unit being a waste heat turbine unit 3 being driven by the waste heat from the ICE, gearing mechanism are provided at 9, 10, between the crankshaft 8 and the waste heat turbine. Said waste heat turbine comprising a steam turbine 12 and a condenser having a condensing chamber 13, expander wheel 49 and nozzles 52; on column 4, lines 51-55, Striebich discloses that the gearing 9, 10, may include a free wheel clutch. Regarding the condensed chamber, please note chamber 61 in the primary reference, Striebich, has condensate and can be considered as condensed chamber. Note column 4, lines 6-9, chamber 61 is called a condenser. Striebich does not disclose 1) the turbine drives an electric generator, and 2) a control unit for controlling the engagement of the clutch in response to the speeds of the auxiliary unit and the engine. Abdelmalek is relied upon to disclose 1) a waste heat expander drives an electric generator 109, and 2) it's well known to have a controller 117 in a hybrid engine to control the clutch 101a, 102a, in

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response to the speeds of an auxiliary unit (electric motor 102) and the main engine (vehicle speed) (note column 6, lines 10-60). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to 1) use the turbine in Striebich to drive an electric generator as taught by Abdelmalek for the purpose of generating electricity, and 2) to replace said free wheel clutch of Striebich by the clutch with a control unit as taught by Abdelmalek for the purpose of more effectively controlling the engagement of the clutch.

Claims 59, 61, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Striebich in view of Abdelmalek and further in view of Kawamura. Striebich as modified discloses all the claimed subject matter as set forth above in the rejection of claim 38, but does not disclose a flywheel. Kawamura is relied upon to disclose it's well known to use a flywheel 2 in a waste heat system of an engine 1. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a flywheel in Striebich as taught by Kawamura for the purpose of storing energy.

Claim 60 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Striebich in view of Kawamura. Striebich discloses all the claimed subject matter as set forth above in the rejection of claim 51, but does not disclose a flywheel. Kawamura is relied upon to disclose it's well known to use a flywheel 2 in a waste heat system of an engine 1. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a flywheel in Striebich as taught by Kawamura for the purpose of storing energy.

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Claims 38-61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6374613, or US patent no. 6729137. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

US 6327613 or US 6729137 anticipates the claimed subject matter of this application. The claims of those patents recite more elements than in this application and therefore the claims of this application should be rejected under obviousness double patenting rejection. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

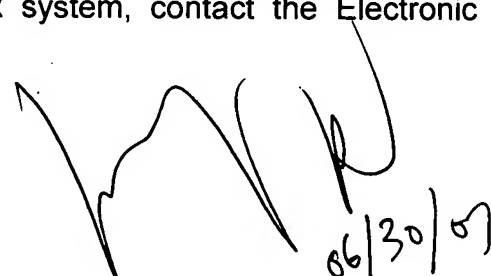
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Nguyen whose telephone number is (571) 272-4861. The examiner can normally be reached on Tuesday--Friday from 12:30 AM to 10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HOANG NGUYEN
PRIMARY EXAMINER
ART UNIT 3748

06/30/07

Hoang Minh Nguyen
6/30/2007